

Attorney Docket No. P70583US0
Application No. 10/534,031

Remarks/Arguments:

Claim 1-3 and 5-23 are pending, with claims 3 and 12-23 being withdrawn as non-elected claims pursuant to an election of species requirement.

Claim 4 is cancelled, without prejudice or disclaimer.

Claim 1 is amended by incorporating subject matter of claim 4. Claim 5 is amended by changing claim dependency from claim 4 to claim 1.

The rejection under 35 USC 112, second paragraph, of claim 4 is rendered moot by cancellation of the rejected claim, hereby.

Claims 1, 2, and 4-11 were rejected under 35 USC 102(b) as being allegedly anticipated by US 4045353 (Kosaka) and, alternatively under 35 USC 103(a) as being allegedly obvious over Kosaka. Claim 5 was rejected under 35 USC 103(a) as being allegedly unpatentable over Kosaka in view of US 4160728 (Kirkland). Claim 9 was rejected under 35 USC 103(a) as being allegedly unpatentable over Kosaka in view of US 5240601 (Mazid). Reconsideration of the aforesaid rejections—relying, *i.a.*, on Kosaka—is requested.

For anticipation under § 102 to exist, each and every claim limitation, as arranged in the claim, must be found in a single prior art reference. *Jamesbury Corp. v. Litton Industrial Products, Inc.*, 225 USPQ 253 (Fed. Cir. 1985). The "absence" from a prior art reference of a single claim limitation "negates anticipation." *Kolster Speedsteel A B v. Crucible Inc.*, 230 USPQ 81, 84 (Fed. Cir. 1986). A reference that discloses "substantially the same invention" is not an anticipation. *Jamesbury Corp.* To anticipate the claim, each claim limitation must "*identically* appear" in the

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reference disclosure. *Gechter v. Davidson*, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997) (*emphasis added*). To be novelty defeating, a reference must put the public in possession of the identical invention claimed. *In re Donahue*, 226 USPQ 619 (Fed. Cir. 1985).

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art," *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970), "and it is error to ignore specific limitations distinguishing over the [prior art] reference." *Ex parte Murphy*, 217 USPQ 479, 481 (PO Bd. App. 1982). A "ground of rejection is simply inadequate on its face . . . [when] the cited references do not support each limitation of [the] claim." *In re Thrift*, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002).

Kosaka neither teaches nor suggests the limitation to "a porous [support] material having at least a bidisperse distribution of pore sizes," as recited in the present claims. Accordingly, the "absence" from Kosaka of the limitation—on the present claims—to a porous support material having at least a bidisperse distribution of pore sizes "negates anticipation" of the present claims by the cited reference. *Kolster Speed Steel AB*, 230 USPQ at 84. To anticipate the claim, each claim limitation must "identically appear" in the reference disclosure. *Gechter*, 43 USPQ2d 1032.

Furthermore, since Kosaka fails to "support each limitation of [the present] claim[s]," the rejection under §103(a) over Kosaka is "inadequate on its face" against the present claims. *Thrift*, 63 USPQ2d at 2008. "All words in a claim must be considered in judging the patentability of that

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claim against the prior art," *Wilson*, 165 USPQ at 496, "and it is error to ignore specific limitations distinguishing over the [prior art] reference." *Murphy*, 217 USPQ at 481.

Neither the secondary reference Kirkland nor the secondary reference Mazid provides any teaching or suggestion, taken alone or in combination with the primary reference (Kosaka), that would cure the fatal deficiency of the primary reference as explained above, i.e., neither one of the secondary references provides any teaching or suggesting that, when taken in combination with Kosaka, would have led one of ordinary skill in the art to "a porous [support] material having at least a bidisperse distribution of pore sizes," to which the present claims are limited. Since "the cited references do not support each limitation of [the present] claim[s]," each of the §103(a) rejections—based on Kosaka in view of Kirkland and based on Kosaka in view of Mazid—applied against any of the present claims is "inadequate on its face." *Thrift*, 33 USPQ2d at 2008.

With respect to the §103(a) rejection based on Kosaka (alone), applicants note the argument set forth in the statement of rejection (Office Action, page 2): "It would have been obvious to optimize the elements of Kosaka . . . to enhance separation." With all due respect, the argument is poorly taken, and cannot be relied on to support the rejection under §103(a), because Kosaka fails to teach or suggest the alleged optimization. That a difference with the prior art amounts to an alleged "optimal condition . . . is not a substitute for some teaching or suggestion supporting an obviousness rejection." *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). An argument by the PTO is "not prior art." 28 USPQ2d at 1957. "Reliance on *per se* rules of obviousness is legally incorrect and must cease." *In re Ochiai*, 37 USPQ2d 1127, 1129 (Fed. Cir. 1995).

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For the foregoing reasons, the rejections against present claims 1, 2, and 5-11 under § 102(b) and under § 103(a)—relying, *i.e.*, on Kosaka—are overcome. Withdrawal of the rejections appears to be in order.

Claims 1, 2, and 4-11 were rejected under 35 USC 103(a) as being allegedly obvious over EP 1020220 or WO0041807 (collectively Kapustine) in view of Mazid. Claim 5 was rejected under 35 USC 103(a) as being allegedly unpatentable over Kapustine in view of Mazid and further in view of Kirkland). Reconsideration of the aforesaid rejections—relying on Kapustine as primary reference—is requested.

Contrary to the statement of rejection, Kapustine does not disclose in any way the limitation on the present claims to "a porous [support] material having at least a bidisperse distribution of pore sizes" (*emphasis added*). Moreover, the presently claimed "sorber material having ... the fluorinated polymer coating ... containing at least one functional group" is not met by Kapustine because the Kapustine material was produced by a materially different process. It is "incongruous" to find "different processes each inherently produce identical products." *W. L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 USPQ 303, 313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

More precisely, the Kapustine process involves the coating of support particles with hydrophobic oligomers, followed by polymerization and fluorination of the resulting support surface using xenon difluoride or a mixture of elemental fluoride and nitrogen. On the other hand, the presently claimed "sorber material" is obtained by coating a porous support with fluorinated (and other) monomers and, then, polymerization of the monomers by irradiation. Thus, in accordance

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with the presently claimed invention, the advantage of introducing "at least one functional group" to "the fluorinated polymer coating" is obtained, in contrast to Kapustine. Lack of "invention set forth in product claims cannot be predicated on mere conjecture respecting the characteristics of products that might result in the practice of processes disclosed in [prior art] references." *W. L. Gore & Assoc., Inc.*, 220 USPQ at 314.

Neither the secondary reference Mazid nor the secondary reference Kirkland provides any teaching or suggestion, taken alone or in combination with the primary reference (Kapustine), that would cure the fatal deficiencies of the primary reference as explained above, i.e., neither one of the secondary references provides any teaching or suggesting that, when taken in combination with Kapustine, would have led one of ordinary skill in the art to either "a porous [support] material having at least a bidisperse distribution of pore sizes" or a "sorber material having ... the fluorinated polymer coating ... containing at least one functional group," to which the present claims are limited. Since "the cited references do not support each limitation of [the present] claim[s]," each of the §103(a) rejections—based on Kapustine in view of Mazid and based on Kapustine in view of Mazid and further in view of Kirkland—applied against any of the present claims is "inadequate on its face." *Thrift*, 33 USPQ2d at 2008.

In particularly, the combination of references provides the skilled person with no teaching or suggestion to modify the sorber material known from Kapustine in the direction of manipulating the dispersion of pore sizes, let alone obtaining "at least a bidisperse distribution of pore sizes," as recited in the present claims. With all due respect, nothing in the prior art would have led the skilled

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artisan to the combination of Kapustine with Mazid, as alleged, and such a combination can only be obtained by employing hindsight. Even the statement of rejection contends only that Mazid teaches materials for ex vivo treatment of biological fluids such as blood or blood plasma (Mazid, column 2 line 21) and prevent the release of particles (fines) from the material.

The teaching of Mazid concerns a process for providing a biocompatible, controlled-pore coating with membrane-type physical properties conferring integrity and mechanical strength, which coating is for use in protecting affinity supports to prevent the release of fines. Although Mazid teaches much concerning a "pore controlling component," the skilled person gets no hint or incentive to provide the material with "at least a bidisperse distribution of pore sizes," as recited in the present claims. On the contrary, it seems that Mazid is teaching away from using two, different pore size distributions, as required by the present claims.

Kirkland, relied on to reject claim 5, mainly uses a mixture of two kinds of particles having a unidisperse—as opposed to a "bidisperse"—distribution, in itself, though the two kinds of particles differ from one another in pore size. By mixing the two pore-size particles together, the separation bed is provided with a bidisperse distribution of pores. However, the particles themselves stay mono-disperse. On the contrary, the present claims limit the "support," itself, to "a bidisperse distribution of pore sizes."

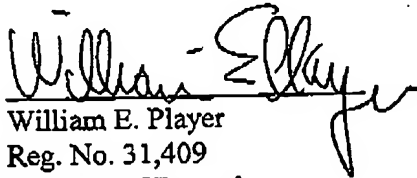
In view of the foregoing, since "the cited references do not support each limitation of [the present] claim[s]," each of the §103(a) rejections—based on Kapustine in view of Mazid and based on Kapustine in view of Mazid and further in view of Kirkland—applied against any of the present

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claims is "inadequate on its face." *Thrift*, 33 USPQ2d at 2008. Withdrawal of the rejections appears to be in order.

Favorable action is requested.

Respectfully submitted,



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